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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,623	06/02/2001	Thomas T. Andersen	010.00121	2288

7590 08/25/2003
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EXAMINER

HUFF, SHEELA JITENDRA

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 08/25/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/872,623

Applicant(s)

ANDERSEN ET AL.

Examiner

Sheela J Huff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) 16-22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-12 is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 6-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

The amendment filed on 7/16/03 has been considered. Applicant's arguments are deemed to be persuasive-in-part.

Claims 1-12 and 16-22 are pending.

Claims 16-22 are withdrawn from consideration.

The rejection of claims 1-3, 5 under 35 U.S.C. 102(a) as being anticipated by Jacobson et al Cancer Detection and Prevention vol. 24 (Supp. 1) 2000 is withdrawn in view of applicant's arguments.

Response to Arguments

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 5 remain rejected under 35 U.S.C. 102(a) as being anticipated by Mesfin et al. Proc. Of the American Assn. For Cancer Research vol. 42 p. 778 (3/01), Abstract #4178. The reasons for this rejection are of record in paper no. 12, mailed 1/23/03.

Applicant argues that all of the peptides in claim 5 are found in the provisional application. The provisional application discloses the following:

in A1, EMTPVNPG (SEQ ID No. 6) and QMTPVNPG (not claimed) are found
in A2, QMTPVNPGE (not claimed) and its cyclic form are found.

In A5-6 EMTOVNOG (Seq Id no. 4), EMTOVNPG (SEQ ID No. 8) and
EMTPVNOG (SEQ ID No. 10) (all of which are claimed) are found

Cyclic forms of the above are also found.

There is no suggestion in the provisional application of adding Q to SEQ ID No. 4, 8 or 10, therefore SEQ ID No. 5, 9 and 11 are not found in the provisional application. If there is a suggestion of adding Q to SEQ ID No. 4, 8 or 10, then applicant is asked to specifically point to page and line number in the provisional.

Claims 1-2 remain rejected under 35 U.S.C. 102(b) as being anticipated by Cantley et al US 5532167, This reference discloses SEQ ID No. 36 which reads on a analog of SEQ Id no. 6 of the instant invention. The reasons for this rejection are of record in paper no. 12, mailed 1/23/03.

Applicant argues that the term "analog" is art-known and cites Dorland's. The definition states that it is "a chemical compound with a structure similar to that of

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another but differing from it in respect to a certain component; it may have a similar or opposite action metabolically". Thus the definition of analog is that the function of the analog need not be that same as that of the parent compound.

Applicant argues that the Examiner has not met the burden as suggested in MPEP 2112. The peptide disclose in the reference reads on applicant's broad claim to an hydrophilic analog of SEQ ID No. 6. Thus, the compound in the reference has amino acids in common with that of the claimed peptide. More importantly applicant is directed to MPEP 2112.01 which states:

Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

In the instant case, the reference peptide is RRPVSPGKD. The highlighted amino acids are in common with that of claims 1 and 2. Thus, the products have structural similarity and a prima facie case has been made.

Claims 1-4 remain rejected under 35 U.S.C. 102(e) as being anticipated by Krystal et al US 6348567. The reasons for this rejection are of record in paper no. 12, mailed 1/23/03.

Applicant's arguments have been addressed above. More specifically, the reference discloses the peptide SVDVEYTVQFTPLNPDDD. The highlighted amino

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acids are in common with that of claims 1 and 2. Thus, the products have structurally similarity and a prima facie case has been made.

Allowable Subject Matter

Claims 9-12 are allowed.

Claims 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J Huff whose telephone number is 703-305-7866. The examiner can normally be reached on Tuesday 5:30am-11:30am and Fridays 6:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Sheela J Huff
Primary Examiner
Art Unit 1642

sjh